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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/633,937	08/08/2000	Patrick Egan	20181-2	4122

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EXAMINER

NGUYEN, CHI Q

ART UNIT	PAPER NUMBER
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3635

DATE MAILED: 05/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/633,937

Applicant(s)

EGAN, PATRICK

Examiner

Chi Q Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 February 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 24-52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 24-52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☒ The proposed drawing correction filed on 08 August 2000 is: a) ☒ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____.

DETAILED ACTION

This Office action is response to the applicant's amendment and supplemental declaration filed on 2/25/03.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Regarding claim 44, the phrase "may be" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 24-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Balla-Goddard (U.S. 5,743,056).

Balla-Goddard discloses building panel comprising a first, exterior, a second, interior facing sheets of generally rigid material 56, and having a first, a second, thickness and a first, a second sheet perimeter, respectively; at least two framing struts 60 being located between the first and second sheets and having struts thickness to define a panel volume between the first, second sheets, and framing struts, a layer of polymeric in-situ foam core 58 comprising polyurethane located in and substantially filling the

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panel volume, a sheet of drywall 52 having a drywall thickness and adjacent the interior facing sheet 56, the drywall having an interior surface, a trim piece 208, a jamb member 206, service ducts 103 are located between the plaster board or drywall 52 and the panel 16 for electricity cables, telephone lines, sewer pipes and/or gas pipes, a window opening (col. 7, lines 40-43, 65-66). The panel has a first vertical side edge having a male projection member 72 adapted to project into a corresponding female reception member 74 on an adjacent panel (figs. 1-9).

Balla-Goddard does not teach specifically the overall panel thickness between approximately 3 3/4 and 4 1/4 inches, the jamb thickness is substantially equal to the sum of the overall panel thickness and the drywall thickness, the struts comprise wooden struts having an actual cross-sectional dimensioning of about 1 1/2" by 3 3/16", and the thermal insulation R-value through a foam containing portion of the thickness of at least 20, the first, second sheets are each made from 7/16" thick OSB, and drywall has a thickness of 1/2".

It would have been obvious to one of ordinary skill in the art at the time the invention was made to choose the desirable thickness to accommodate the opening gap, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or working ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

With regards to claims 32, 40, 43, and 50, Balla-Goddard teaches the structural elements for the wall panel except for the struts are wooden. It would have been obvious to one having ordinary skill in the art at the time the invention was made to

have wooden struts, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ.

Response to Arguments

5. Applicant's arguments with respect to claims 24-52 have been considered but are moot in view of the new ground(s) of rejection.

In respect to the declaration of Mr. Patrick Egan filed on 2/11/03, examiner had fully considered, however the applicant's claimed invention is ineffective to overcome the prior art because: As stated in paragraph 4, Balla-Goddard teaches the structural elements for the wall panels except for the panel overall thickness in the range of 3-3/4" and 4-1/4". Examiner considers this would have been obvious to one having ordinary skill in the art at the time the invention was made to minimize the panels at overall thickness within the range of 3-3/4" and 4-1/4" in order to maximize material cost saving, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or working range involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Martella et al. (US 6,041,562), Beier (US 5,836,628) teach structural elements for wall panel and window/door jam, respectively.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chi Q. Nguyen whose telephone number is (703) 605-1224, Monday-Thursday (7:00-5:30), Fridays off or examiner's supervisor, Carl Friedman can be reached at (703) 308-0839. The fax number for the organization

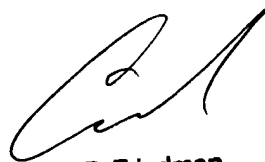
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where this application or proceeding assigned are (703) 872-9326 for regular communications and (703) 872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.



CQN
5/7/03



Carl D. Friedman
Supervisory Patent Examiner
Group 3600